

Remarks/Arguments

Claims 1-37, 43-46, 50-51, 58-59 and 61 remain in the case. Claims 38-42, 47-49, 52-57 and 60 were previously cancelled. Claims 1-37, 43, 50 and 59 were previously allowed over the prior art. No claims are currently amended. Claims 62 and 63 are currently
5 newly presented.

Claims 1-37 stand allowed.

The allowability of claims 43, 50 and 59 was withdrawn.

Reissue Oath/Declaration

The reissue oath/declaration originally filed in the instant reissue application was
10 found defective for failing to identify at least one error which was relied upon to support the reissue application.

A Supplemental Declaration for Reissue Patent Application is filed herewith including a detailed description of at least one error which was relied upon to support the reissue application. To wit, the patented claims failed to include one or more claims directed to the
15 method of the invention which was described in detail in the Specification. Accordingly, the Applicant now believes the requirement under 37 CFR § 1.175(a)(1) to be satisfied.

Claim Rejections

Claims 43-46, 50-51, 58-59 and 61 were rejected under 37 CFR § 1.175(d) for failing to underline new claims 38-56 when presented by the Preliminary amendment filed on
20 December 7, 2000, and for failing to underline new claims 57-61 when presented by the amendment filed on January 14, 2002.

Claims 38-61, except cancelled claims 38-42, 47-49, 52-57 and 60, are presented herein in underlined fashion. While the Applicant believes the Preliminary amendment as originally filed satisfied the requirements in effect at the time of the filing, the Applicant now
25 believes the requirements presently in effect under 37 CFR § 1.175(d) to be satisfied.

Claims 43-46, 50-51, 58-59 and 61 were rejected under 37 CFR § 1.175(c) for failing to set forth the current status of all patent claims and all new claims presented in the reissue application.

Claims 1-61 are presented herein in their current condition, including any amendments thereto, and setting forth the current status of each patent claim and each new claim presented in the reissue application.

5 Furthermore, the Applicant has sincerely attempted to comply with the requirements set forth in the Office Action dated February 27, 2004, and 37 CFR § 1.175 as presently in effect, and as interpreted by lengthy telephonic conference with the Examiner on May 19, 2004.

Allowable Subject Matter

10 The Examiner is thanked for notifying the Applicant that originally patented claims 1-37 remain allowable.

Recapture

Pending claims 43-46, 50-51, 58-59 and 61 were rejected under 35 USC § 251. The Office Action suggest that the broadened claims presented in the reissue application attempt to recapture subject matter surrendered in the application for the patent upon the present reissue application is based. The Applicant strongly disagrees.

15

The application for the patent upon the present reissue application is based was originally filed with both narrow and broad claims, including original claim 20 (set forth below) which set forth and claimed the simple, core principles underlying the present invention.

Original Claim 20:

20 A universal mounting joint for adjustably coupling a first device to a second device, comprising:

a ball assembly including a mounting ball having an outer surface and a fastening unit secured to said first mounting ball for securing said mounting ball to the first device, said first mounting ball being formed from compressible material;

25 a pair of spaced-apart sleeve elements coupled over said first mounting ball, each said sleeve element having an interior surface that defines a socket surface, wherein said first mounting ball is located adjacent said sleeve element interior surfaces, said sleeve elements including a fastening assembly for securing said sleeve elements to the second device; and

a coupling assembly connected between said sleeve elements for selectively urging said sleeve elements together so as to cause said sleeve elements to become partially embedded in said outer surface of said first mounting ball.

The application for the patent upon the present reissue application is based has a
5 very long record in which underlying applications were abandoned in favor of file wrapper
continuation (FWC) applications filed under then 37 CFR § 1.62. Several preliminary
amendments were filed in the FWC applications, whereby some rejected claims were cancelled
and new claims were presented, without remarks or arguments being presented by the Applicant
as to reasons for patentability over prior art references and without remarks or arguments being
10 presented as to patentable distinctions between the prior art references and the claimed
invention.

The following is a brief outline of the file history of the application for the patent
upon the present reissue application is based.

April 28, 1995

15 In the FWC dated April 28, 1995, the Applicant filed a Preliminary amendment
that cancelled claims 2-25 without remark or argument being presented.

May 13, 1996

In the Preliminary amendment dated May 13, 1996, the Applicant presented new
claims 26-37 and argued that the arrangement taught by prior art reference by Giller (US Patent
20 2,710,609) is "wholly different" from the present invention because of reliance on "spring steel
strips" 25, 26 and the location of spring 40 and screw 27 combination. Additionally, the
Applicant merely argued that the other prior art references: White (US Patent 596,729), Rustrom
(US Patent 5,071,279), Hoshino (US Patent 4,796 508) and Berg (Swedish patent 497) all "add
nothing" over what Giller taught. See, Preliminary amendment May 13, 1996, pages 16-17.

25 The Preliminary amendment dated May 13, 1996, further stated that the
secondary references cited by the Office Action "do nothing to teach or suggest" the Applicant's
assembly because they fail to disclose or suggest plain part spherical inner peripheral surfaces of
sockets having sufficient arcuate extent that, when clamped together, they act like "pressure
pads" to compress the surface of the ball. See, Preliminary amendment May 13, 1996, page 16,
30 line 23-page 17, line 6.

Moreover, the Preliminary amendment dated May 13, 1996, was not entered.
October 30, 1996

In the Preliminary amendment dated October 30, 1996, the Applicant cancelled claims 26-37 and presented new claims 38-53. The Applicant described the new claims as being
5 “simpler” and “more direct” and related the claims to the specification. See, Preliminary amendment October 30, 1996, page 8.

In the Preliminary amendment dated October 30, 1996, the Applicant also offered argument relative to the prior art references. Regarding Giller, the Applicant explained that the “springingness” of the “arm sections” taught by Giller is a “controlling principle” of the teaching
10 and “quite contrary to the principles of the Applicant’s invention.” See, Preliminary amendment October 30, 1996, page 9, lines 3-14.

The Applicant further argued that the secondary references “do not teach the reader how to bridge the wide gap between the invention and the controlling principle of Giller.” See, Preliminary amendment October 30, 1996, page 9, lines 15-22.

15 November 6, 1996

In the Preliminary amendment dated November 6, 1996, the Applicant repeated the cancellation of claims 26-37 and the presentation of new claims 38-53. The Applicant repeated the description of the new claims as being “simpler” and “more direct” and related the claims to the specification. See, Preliminary amendment November 6, 1996, page 9, lines 3-20.

20 In the Preliminary amendment dated November 6, 1996, the Applicant also repeated the argument relative to the prior art references. Regarding Giller, the Applicant again explained that the “springingness” of the “arm sections” taught by Giller is a “controlling principle” of the teaching and “quite contrary to the principles of the Applicant’s invention.” See, Preliminary amendment November 6, 1996, page 9, line 21-page 10, line 2.

25 The Applicant further argued that the secondary references “do not teach the reader how to bridge the wide gap between the invention and the controlling principle of Giller.” See, Preliminary amendment November 6, 1996, page 10, lines 3-10.

May 16, 1997

In the Preliminary amendment dated May 16, 1997, the Applicant added new
30 claims 54-76, cancelled claims 45 and 57, and amended claims 38-40. The amendment of claims

38-40 is the first claim amendment introduced by the Applicant in the entire history of the application process.

5 The Applicant also explained the patentable distinction of the invention over newly cited prior art reference Cyrell (US Patent 5,251,859) stating that the sockets 18, 22 as taught by Cyrell are “toothed” to grip a compressible coupling member 24 such that the “teeth in the sockets 18, 22 can sink somewhat in to the [compressible coupling member 24].” See, Preliminary amendment May 16, 1997, page 32, lines 7-17.

10 The Applicant goes on to explain that the newly cited prior art reference to Hodny (US Patent 1,455,441) is distinguishable as teaching hard metal balls 15, 23 and a pair of arm sections 24 that “frictionally engage” the metal balls under clamping forces. See, Preliminary amendment May 16, 1997, page 32, lines 18-21.

The Applicant also distinguished the compressible coupler member of the present invention from the White reference that teaches balls 20, 21 that are also metal. See, Preliminary amendment May 16, 1997, page 32, lines 22-23.

15 The Applicant also distinguishes the invention as the coupling members being of a “pressure deformable material” that is “squeezed” between the smooth clamping surfaces “to less than the diameter” of the circle of revolution of the first coupling member. See, Preliminary amendment May 16, 1997, page 32, lines 24-31. This states the basic principle of the invention.

20 The argument offered by the Applicant thus goes to distinguish the “squeezing” of the coupling member to a lesser diameter of the present invention from both the digging “toothed” grip of the Cyrell reference and from the “frictional” engagement of the Hodny reference.

March 16, 1998

25 In a final Preliminary amendment dated March 16, 1998, the Applicant offered very minor amendments to claims 38, 54 and 74-76 that appear to merely clarify the matter already claimed without affecting the scope of the amended claims. See, Preliminary amendment March 16, 1998, pages 29-40; and Remarks at page 41, line 26-page 42, line 7.

30 The Applicant also explained the compressible nature of the coupler members of the invention as set forth in the Specification. See, Preliminary amendment March 16, 1998, page 42, line 15-page 43, line 6.

The remainder of the Remarks presented in the March 16, 1998, Preliminary amendment are directed to the mechanics of claims drafting and thus do not address patentability of the invention. See, Preliminary amendment March 16, 1998, page 43, line 7-page 44, line 24.

May 26, 1998

5 In the Office Action mailed May 26, 1998, the Examiner allowed claims 38-44, 46, and 48-76 by reason of the prior art failing to disclose or suggest a "mounting assembly comprising a split arm assembly forming a bifurcated arm assembly which has its apex at the second locus of the base and is engaged about the first coupling member." See, Office Action Summary mailed May 26, 1998, at paragraph: Allowable Subject Matter.

10 June 22, 1998

In the Notice of Allowability mailed on June 22, 1998, the Examiner repeated the reasons for allowance recited in the Office Action mailed May 26, 1998. See, Notice of Allowability mailed on June 22, 1998, at paragraph: Allowable Subject Matter.

September 18, 1998

15 In the Comments On Statement Of Reasons For Allowance dated September 18, 1998, the Applicant stated that, in addition to the reasons for allowance given by the Examiner, the claims are allowable for the first sockets of the arm sections with the first coupling member form a ball and socket joint whereby the pair of arm sections squeeze the body of the first coupling member therebetween and interlock the pair of arm sections with the first coupling member to rigidify the connection. And furthermore, that a differential in the reaction is produced between the first and second sockets of the arm sections for pivoting the first and second pairs of arm sections in relation to one another. See, Comments On Statement Of Reasons For Allowance dated September 18, 1998, entire.

Analysis

25 Careful review of the file history, as outlined in brief above, shows conclusively that the simple, core principles underlying the present invention were never in any way surrendered by the originally filed application nor at any time during prosecution of the application for the patent upon the present reissue application is based.

The original patent application set forth the invention in both independent claims 30 13 and 20, briefly, as a single mounting ball formed from compressible material, a pair of sleeve

elements having socket surfaces and a fastening assembly, and a coupling assembly connected between the sleeve elements for urging them together relative to the mounting ball. At no time during the subsequent prosecution of the application did the Applicant veer from the patenting of this originally claimed invention nor surrender this originally claimed subject matter.

5 During early stages of the application, the Applicant chose to cancel most of the originally filed claims, but offered no argument or remark as to the reasons underlying the cancellation. Thus, the Applicant offered no argument or remark that can be reasonably construed as having surrendered the subject matter of the original application. Clearly the Applicant did not surrender of the subject matter of the original application. Furthermore, the
10 Examiner in the instant Office Action failed to point to any argument or remark by the Applicant that could be so construed.

 In the Preliminary amendment dated May 13, 1996, the Applicant presented new claims and presented argument that the prior art reference by Giller (US Patent 2,710,609) is “wholly different” from the present invention, and furthermore that the secondary references “do
15 nothing to teach or suggest” the Applicant’s assembly. This is because they fail to disclose or suggest the simple, core principles underlying the present invention, whereby the smooth surfaces of sockets act like “pressure pads” to compress the surface of the ball. Such descriptions of the prior art references cannot possibly be construed as surrender of the subject matter of the original application. Again the Applicant clearly did not surrender of the subject matter of the
20 original application. Furthermore, the Examiner in the instant Office Action failed to point to any argument or remark by the Applicant that could be so construed.

 In the Preliminary amendment dated October 30, 1996, the Applicant substituted new claims that the Applicant described as being “simpler” and “more direct” than the cancelled claims. As to the prior art references, the Applicant remarked that the “controlling principle” of
25 the Giller reference was “quite contrary to the principles of the Applicant’s invention.” Further, the Applicant stated that the secondary references “do not teach the reader how to bridge the wide gap between the invention and the controlling principle of Giller.” Thus, the Applicant cannot be said to have surrendered of the subject matter of the original application because the prior art reference taught nothing that required such surrender. Additionally, the Applicant’s
30 clear denial that the prior art was even vaguely pertinent to the invention makes it clear that the

Applicant did not surrender of the subject matter of the original application. Furthermore, the Examiner in the instant Office Action again failed to point to any argument or remark by the Applicant that could be so construed.

5 In the Preliminary amendment dated November 6, 1996, the Applicant repeated the earlier clear denial that the prior art was even vaguely pertinent to the invention. Thus, the Applicant again clearly did not surrender of the subject matter of the original application.

In the Preliminary amendment dated May 16, 1997, the Applicant added new claims, cancelled two claims, and amended three claims. That this is the first time during an already lengthy prosecution that the Applicant amended any claims makes it clear that the
10 Applicant was not willing to surrender any of the subject matter of the original application. Furthermore, the amendment matter is directed to only a few of the claims and is clearly intended to provide only the additional subject matter the Applicant believed to be allowable, as set forth in the Comments On Statement Of Reasons For Allowance dated September 18, 1998.

The argument and remarks made in the Preliminary amendment dated May 16,
15 1997, again distinguish the teachings of the prior art references from even the most basic principles of the Applicant's invention. Rather than surrendering any subject matter of the original application, the Applicant argued that the prior art references all taught subject matter that is distinctly different from the basic principles of the Applicant's invention. For example, the Applicant remarked that Cyrell teaches sockets that are "toothed" to "sink somewhat" into a
20 compressible coupling member, which is clearly distinct from the basic principle of distorting the "pressure deformable material" coupling member by "squeezing" it between smooth clamping surfaces "to less than the diameter" of the coupling member.

Regarding the secondary references Hodny and White, the Applicant again points to the basic distinction that the balls taught by these reference are metal so that they cannot be
25 combined with the Cyrell reference to teach the "squeezing" of a "pressure deformable" coupling member between smooth clamping surfaces "to less than the diameter" of the coupling member, which are the basic simple, core principles underlying the present invention.

The arguments offered by the Applicant thus go to distinguish the "squeezing" of the "pressure deformable" coupling member between smooth clamping surfaces to a lesser

diameter from both the digging “toothed” grip of the Cyrell reference and from the “frictional” engagement of the Hodny reference.

Since the prior art references clearly fail to disclose or suggest any of the basic simple, core principles underlying the present invention, the arguments and remarks set forth by the Applicant for distinguishing these patentable features clearly do not surrender any of the subject matter of the original application. Furthermore, the Examiner in the instant Office Action again failed to point to any argument or remark by the Applicant that could be so construed.

Finally, in the Comments On Statement Of Reasons For Allowance dated September 18, 1998, the Applicant stated that the belief that, in addition to the reasons for allowance given by the Examiner, the claims are allowable because the sockets of the arm sections squeeze the body of the coupling member therebetween and interlock the arm sections with the coupling member to rigidify the connection. Thus, even after proceedings on the application were closed, the Applicant still put forth arguments as to the patentability of the basic simple, core principles underlying the present invention.

Conclusion:

Careful study of the file history shows conclusively that the Applicant clearly did not surrender any of the subject matter of the original application at any time during the lengthy prosecution of the application.

Furthermore, as pointed out above, the Examiner in the instant Office Action completely failed to point to even one single instance, argument or remark by the Applicant that could possibly be construed as surrender of any of the subject matter of the original application at any time during prosecution of the application.

For each of the above reasons, the Applicant believes that the subject matter of previously allowed claims 43-46, 50-51, 58-59 and 61 was clearly not surrendered in the application for the patent upon the present reissue application is based. Based on the above, the Applicant believes that the subject matter of previously allowed claims 43-46, 50-51, 58-59 and 61 was clearly not an attempt to recapture subject matter surrendered in the application for the patent upon the present reissue application is based.

Therefore, the Applicant respectfully requests reconsideration and reinstatement of the allowance of the claims 43-46, 50-51, 58-59 and 61.

Newly Presented Claims

Newly presented claims 62 and 63 both recite the split arm assembly forming a bifurcated arm assembly which has its apex at the second locus of the base and is engaged about the first coupling member, as was found to be allowable by the Examiner during prosecution of the application for the patent upon the present reissue application is based.

As discussed herein above, in the Office Action mailed May 26, 1998, and again in the Notice of Allowability mailed on June 22, 1998, the Examiner gave as reasons for allowance that the prior art fails to disclose or suggest a "mounting assembly comprising a split arm assembly forming a bifurcated arm assembly which has its apex at the second locus of the base and is engaged about the first coupling member." See, Office Action Summary mailed May 26, 1998, at paragraph: Allowable Subject Matter; and see, Notice of Allowability mailed on June 22, 1998, at paragraph: Allowable Subject Matter.

Furthermore, as the Examiner found the subject matter of newly presented claims 62 and 63 to be allowable during prosecution of the application for the patent upon the present reissue application is based, the Applicant clearly did not surrender the subject matter in the application for the patent upon the present reissue application is based. Also, because the subject matter was found to be allowable, presentation of new claims 62, 63 is clearly not new subject matter and, furthermore, is clearly not an attempt to recapture previously surrendered subject matter.

For at least the above reasons, newly presented claims 62 and 63 are believed to be allowable.

The claims now being in form for allowance, reconsideration and allowance is respectfully requested.

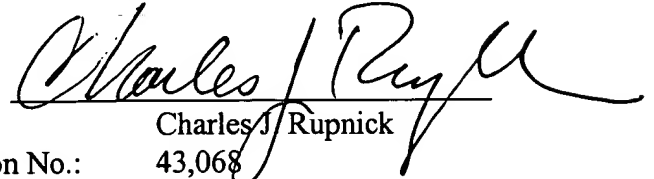
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If the Examiner has questions or wishes to discuss any aspect of the case, the Examiner is encouraged to contact the undersigned at the telephone number given below.

Respectfully submitted,

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